

A substitute sheet for page 3 of the preliminary amendment is attached. The undersigned verifies that the substitute is a true copy of the originally filed sheet, except for the provision of a wider top margin.

In claim 8, the term used was "rotator means", not "rotating means". Rotator is a term known in telecommunications switching and is, for example, used in Beshai cited by the Examiner. "Multiplex", as used at line 6 of Claim 8 was an error, and is not used in new claim 9. As each input port is connected cyclically by the rotator means, the objection is not understood.

On the merits, the Examiner in considering Takeuchi and Beshai, assumes, without any evidence as to the practicality of such an approach, that it is possible to include the rotators of Beshai in the switch of Takeuchi. It is, in fact, not possible to include rotators in Takeuchi by any simple means and such a suggestion by the Examiner has no foundation.

Additionally, Takeuchi is an ATM switch as acknowledged by the Examiner, while the present invention is an STM switch. Beshai, at col. 6, lines 31-33, suggests an STM/ATM hybrid switch and not a pure STM switch.

Even if it were possible to include rotators in Takeuchi, this would not convert Takeuchi to an STM switch and there is no indication of how to carry out such a conversion, which conversion does not appear possible.

The Examiner is thus suggesting that the ATM switch of Takeuchi can be converted to an STM switch on the basis of a reference to a hybrid STM/ATM switch in Beshai and that the rotator of Beshai can be added to the converted switch of Takeuchi, there

being no teaching in either Takeuchi or Beshai that the above can or should be carried out. It would appear that the Examiner is attempting to conclude that the cited references anticipate or make obvious the combination of elements of the claims by the use of hindsight. Such use of hindsight is frowned upon and precluded by the courts.

Applicants would like to bring to the Examiner's attention a number of cases.

These cases follow below:

Patterson-Ballagh Corp., et al. v. Moss, et al., Court of Appeals, 9th Cir., 96 USPQ 206. It is quite apparent that simplicity alone will not preclude invention. Hindsight tends to color the seeming obviousness of that which in fact is true contribution to prior art. "Knowledge after the event is always easy, and problems once solved present no difficulties, indeed, may be represented as never having had any, and expert witnesses may be brought forward to show that the new thing which seemed to have eluded the search of the world was always ready at hand and easy to be seen by a merely skillful attention. Diamond Rubber Co. v. Consolidated Rubber Tire, 220 U.S. 428, 435 (1911).

The Supreme Court, in Calmar, Inc. v. Cook Chemical Co., mentioned the danger of "slipping into hindsight", and cited the case of Monroe Auto Equipment Co. v. Heckethorn Mfg. & Sup. Co., 332 F.2d 406, 141 USPQ 549 (6th Cir.) 1964, wherein the doctrine was stated:

"We now come to the patented device which after all is the subject matter of this case. At the outset we take note of two well established principles. The first is that in considering the question of obviousness, we must view the prior art from the point in time just prior to when the patented device was made. Many things may seem obvious after they

have been made, and for this reason courts should guard against slipping into the use of hindsight. We must be careful to "view the prior art without reading into that art teachings of the pellets invention". Application Sporck, 301. F. 2d 686, 689 (CCPA).

In re Imperato, 179 USPQ 730 (CCPA 1973), with regard to the principal rejection, we agree that combining the teaching of Schaefer with that of Johnson or Amberg would give the beneficial result observed by appellant. However, the mere fact that those disclosures can be combined does not make the combination obvious unless the art also contains something to suggest the desirability of the combination. In re Beigel, CCPA 1102, 292 F.2d 955, 130 USPQ 206 (1961). We find no such suggestion in these references.

Prior art must be viewed without the benefit of hindsight afforded by the claimed invention. Hodosh v. Block Drug Co., 786 F.2d 1136, 1143 n.5 (229 USPQ 182, 187 n.5) (Fed. Cir.), denied, 107 S.Ct 106 (1986). Further, when a claimed invention is a combination of features previously used in two separate inventions, "the claimed invention must be considered as a whole, and the question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination". Lindemann, 730 F.2d at 1462 (22 USPQ at 488-89 (1984).

As shown from the above-quoted cases, the mere fact that a reference cited by an Examiner may be modified does not allow an Examiner to meet his burden for showing obviousness absent a suggestion in the cited art of the desirability of the modification. None of the cited references makes such a suggestion relative to the claims now presented. Moreover, it has been held that an Examiner "may not use the claimed invention as an

instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious" (*In re Fritch*, 23 USPQ 2d 1780 (Fed. Cir. 1992).

Applicants have shown that the claims as now presented are in condition for allowance. Accordingly, it is respectfully requested that such action be taken, and the case passed to issue.

Petition is hereby made for a three-month extension of the period to respond to the outstanding Official Action to September 19, 1996. A check in the amount of \$900.00, as the Petition fee, is enclosed herewith. If there are any additional charges, or any overpayment, in connection with the filing of the amendment, the Commissioner is hereby authorized to charge any such deficiency, or credit any such overpayment, to Deposit Account No. 11-1145.

Wherefore, a favorable action is earnestly solicited.

Respectfully submitted,

KIRSCHSTEIN, OTTINGER,
ISRAEL & SCHIFFMILLER, P.C.
Attorneys for Applicant(s)
551 Fifth Avenue
New York, New York 10176-0024
Tel: (212) 697-3750
Fax: (212) 949-1690



Alan Israel
Registration No. 27,564